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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,772	09/05/2003	Dau Min Zhou	S232-USA	7230
7590	09/22/2006		EXAMINER	KAHELIN, MICHAEL WILLIAM
Second Sight Medical Products, Inc. Building 3 12744 San Fernando road Sylmar, CA 91342			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/655,772	ZHOU ET AL.
	Examiner	Art Unit
	Michael Kahelin	3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 June 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-28 is/are pending in the application.  
 4a) Of the above claim(s) 1-20, 23 and 27 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 21, 22, 24-26, 28 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 05 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 20060725.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. 20060906.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-20, 23, and 27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/30/2006.
2. Applicant's election with traverse of claims 21, 22, 24-26, and 28 in the reply filed on 6/30/2006 and telephonic conversation of 9/5/2006 is acknowledged. The traversal is on the ground(s) that examination of all claims poses no serious burden on the examiner. This is not found persuasive because serious burden is shown, an restriction proper, if the inventions acquire separate status in the art in view of their different classification. As indicated in the previous Office Action, the inventions have acquired different status in the art.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 21, 22, 24-26, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In regards to claims 21 and 22, it is unclear whether the surface coating or the combination coating/substrate comprises the platinum, iridium oxide, and platinum gray. The claim appears to recite a platinum gray substrate with a platinum and iridium oxide coating. However, the disclosure seems to describe a platinum or platinum gray substrate with an iridium oxide coating.

6. In regards to claim 28, it is unclear how the gradient composition can be both sputtered (as recited in claim 21) and electroplated (as recited in claim 28). Examiner is interpreting the two methods as being claimed in the alternative.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 21, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker, Jr. (US 4,679,572, hereinafter “Baker”).

9. In regards to claim 21, Baker discloses an implantable electrode comprising an electrode body (10) having a substrate (15) and a sputtered surface coating comprised of a gradient composition of platinum and iridium oxide (col. 7, lines 6-61).

10. In regards to claim 28, the surface coating may also be applied by electroplating (col. 3, line 37).

11. In regards to claim 24, the substrate surface is rough (col. 7, line 41).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, or in the alternative, over Baker in view of Bolz et al. (US 5,571,158, hereinafter "Bolz"). Baker discloses the essential features of the claimed invention including a porous platinum substrate, but is silent as to whether this platinum layer is "platinum gray". Bolz teaches of providing an electrode with a fractal platinum substrate (platinum gray) to provide a biocompatible electrode requiring little stimulation energy (col. 3, line 18). Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to modify Baker's invention by providing a platinum gray substrate to provide a biocompatible electrode requiring little stimulation energy.

15. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Munshi et al. (US 5,654,030, hereinafter "Munshi"). Baker discloses the essential features of the claimed invention except for a sandblasted or abraded surface. Munshi teaches that it is well known in the art to sandblast/abrade electrodes to increase their surface area, this lowering required stimulation energy. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker's invention by sandblasting/abrading the substrate to increase the surface area, this lowering required stimulation energy.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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9/6/06

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George Evans  
Primary Exam 3762

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